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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,877	01/14/2004	Thomas P. Feist	08CN8803-28	5188

23413 7590 08/17/2005

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EXAMINER
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KIM, PAUL D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SR

# Office Action Summary

Application No.

10/757,877

Applicant(s)

FEIST ET AL.

Examiner

Paul D. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/13/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This office action is a response to the election of species filed on 7/6/2005.

#### ***Response to the Election of Species***

1. Applicant's election without traverse of Species B, claims 18-22, in the reply filed on 7/6/2005 is acknowledged.
2. Claims 1-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/6/2005.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandstrom (US PAT. 5,972,461) in view of Murakami et al. (US PAT. 5,426,632).

Sandstrom teaches a process of making an optical data storage disk comprising steps of: injection molding a substrate comprising a plastic surface (such as thermoplastics or thermosets as per claim 20) and a preformed core (such as metal or glass; as per claim 19); and disposing a reflective layer on at least one surface of the substrate; wherein the data storage media has an axial displacement peak of less than

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about 62 microns under shock or vibration excitation (see also col. 7, lines 4-54).

Sandstrom also teaches that the substrate could be formed from two or more layers bonded together such as laminating (equivalent with coating, as per claim 22) the plastic (polycarbonate) and the core (metal or glass). However, Sandstrom fails to teach surface features (such as pits) of the substrate. Murakami et al. teach a process of making a data storage disk including a reflective layer formed on a pits formed substrate, which is for corresponding to data to be reproduced. Pre-pits have been formed on the plastic substrate by injecting molding (see also col. 1, lines 17-26). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the substrate of Sandstrom by a pits formed substrate as taught by Murakami et al. for corresponding to data to be reproduced.

As per claim 21 at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to apply the material as recited in the claimed invention because Applicant has not disclosed that the material as recited in the claimed invention provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with Sandstrom because the material as recited in the claimed invention would perform equally well such as thermoset or thermoplastic material for the substrate in Sandstrom. Therefore, it would have been an obvious matter of design choice to modify the thermoset or thermoplastic material of Sandstrom to obtain the invention as specified in claim 21.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D. Kim whose telephone number is 571-272-4565. The examiner can normally be reached on Monday-Friday between 7:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul D Kim  
Examiner  
Art Unit 3729